

Remarks

Applicants request reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

The present Preliminary Amendment is being filed to address the failure in the Amendment After Final Rejection to comply with the requirements of 37 C.F.R. § 1.121(c).

Claims 1-38 are pending in this application. Claims 1, 12, 27, 31, and 37 are the independent claims. Claims 31-38 were previously withdrawn from consideration as being drawn to a non-elected invention.

Claim 3 has been amended. No new matter has been added.

Claims 1-30 were rejected in the Final Office Action mailed June 24, 2003, under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,470,627 (Lee et al.) in view of U.S. Patent No. 6,165,391 (Vedamuttu). This rejection is respectfully traversed.

Applicants respectfully submit that the Office has failed to establish a prima facie showing of obviousness because the requisite motivation to make the asserted combination is not present.

The Office Action acknowledges that the primary citation to Lee et al. does not teach or suggest micro-embossments protruding from a substrate. Nonetheless, the Office Action contends that Vedamuttu supplies the necessary teaching or suggestion of this feature. (Office Action, page 4). This contention is respectfully traversed.

The secondary citation to Vedamuttu relates to the manufacture of an optical data storage disc. Vedamuttu teaches an apparatus for embossing a disc that includes a nickel shim 26 insulated from an anvil 28 by a film of insulating material 29. Vedamuttu further teaches that the shim is insulated because it is heated during the embossing operation so as to raise the temperature of the lacquer layer 13 covering a plastic substrate 10. (Vedamuttu, Col. 6, line 53-Col. 7, line 10; FIG. 4). Indeed, Vedamuttu expressly teaches that a mirror image of the impression 27 on the shim is embossed on the lacquer surface. (Vedamuttu, Col. 7, lines 1-4). Thus, as the Office Action expressly acknowledges (Office Action, page 3), Vedamuttu does not supply a teaching or suggestion of embossing a substrate; rather it supplies a teaching or suggestion of embossing the lacquer layer surrounding a substrate. This is not surprising since Vedamuttu embosses to form a micro-relief pattern for forming a holographic image on the surface of the disc, not to generate track guides. (Vedamuttu, Col. 4, lines 52-54).

int use

The Manual of Patent Examining Procedure (MPEP) requires, to establish a prima facie case of obviousness, that:

... either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Carri view MPEP § 2142, original eighth edition August 2001, revised February 2003, page 2100-124, left column.

Here, as explained supra, Lee et al. teaches tracking grooves cut into a substrate while Vedamuttu teaches an embossed lacquered layer. Neither Lee et al. nor Vedamuttu expressly or impliedly teaches or suggests the aforementioned features of claims 1, 12, and 27. Thus, they do not expressly or impliedly suggest the claimed invention. Therefore, to establish a prima facie case of obviousness, the Office must present a convincing line of reasoning as to why the [holographic image generating embossment of the lacquer layer of a disc described in Vedamuttu should be added to the tracking grooves described in Lee et al.] However, the "convincing line of reasoning" provided is that it would be obvious to combine these teachings to visually enhance the disc. (Office Action, page 5). The Office has provided none of the necessary evidence that the visual enhancement of a disc disclosed in Vedamuttu--by embossing the lacquer surface of a disc--would be desirable or effective with Lee et al.'s tracking groove. Further, visually enhancing a disc is not taught or suggested by Lee et al. (*attributing*
idea)

Therefore, without conceding the propriety of combining Lee et al. and Vedamuttu in the manner proposed in the Office Action, it is submitted that the Office has not established a prima facie case of obviousness and that the asserted combination fails to teach or suggest at least the aforementioned features of independent claims 1, 12, and 27.

Independent claims 1, 12, and 27 are allowable for another reason. Independent claims 1, 12, and 27 respectively recite, inter alia,

a substrate having flat portions ... and micro-embossments ... protruding from surfaces of the flat portions ... (claim 1);

a substrate having a first surface ... with first protrusions extending from the first surface ... (claim 12); and

a substrate ... having a first surface ... and first protrusions extending from the first surface ... (claim 27).

Applicants also respectfully submit that neither Lee et al. nor Vedamuttu, either alone or in combination (assuming arguendo that these citations may properly be combined), teaches or suggests at least the aforementioned features of independent claims 1, 12, and 27 Dis

Lastly, at pages 3 and 5 of the Office Action, it is implied that the aforementioned features of claims 1, 12, and 27 are obvious as a mere reversal of the grooves of Lee et al., and In re Einstein is cited in support. This characterization of the claims ignores the fact that "merely reversing" the tracking grooves of Lee et al. would: (1) render the optical media of Lee et al. unsatisfactory for its intended purpose; and (2) change the principle of operation of Lee et al. Such results are expressly prohibited by MPEP, § 2143.01, page 2100-127. Moreover, even if Lee et al. could be modified in the manner suggested by the Office Action, that fact is insufficient to establish a prima facie case of obviousness. Id. at 2100-126. Thus, this contention is traversed as without basis in law or fact. lame
Support

In view of the foregoing, Applicants respectfully submit that the independent claims patentably define the present invention on the citations of record. The dependent claim should also be allowable for the same reasons as the respected base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicants believe that the present amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

Applicants submit that this Amendment After Final Rejection clearly places the subject application in condition for allowance. This Amendment was not earlier presented because Applicant believed that the prior Amendment placed the subject application in condition for allowance. Accordingly, entry of the instant Amendment as an earnest attempt to advance prosecution and reduce the number of issues, is requested under 37 C.F.R. § 1.116.

There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

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If there are any additional fees associated with the filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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10/23/04

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